REMARKS

The Office Action dated October 5, 2005 has been received and carefully considered. The following remarks are being submitted as a full and complete response to the Office Action. No amendments to the claims have been made.

Claims 1 to 22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brasseur et al. (U.S. Patent No. 6,439,997) in view of the AdoptionSolutions.com website.

It is a fundamental principle of patent law, when rejecting claims based on a combination of references, that there must be a suggestion or motivation to make the combination. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Motivation to combine or modify must be present and enunciated in some manner *in the prior art*. The suggestion to combine cannot be based on statements or material taken only from the present specification, as doing so constitutes proscribed hindsight. Enlightened by the content of the present specification, it is improper for the Examiner to find a reason to combine the cited references where such reason is not taught in the cited prior art, but rather only by teachings in the present specification. The relevant inquiry is whether "an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor *and with no knowledge of the claimed invention*, would have selected the

various elements from the prior art and combined them in the manner claimed." Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005) (emphasis supplied).

The applicant respectfully submits that the modification proposed in the Office Action lacks the necessary motivation to combine, since neither of the citations provides any suggestion or reason therein to make the proposed combination. On the contrary, the motivation to combine, as stated by the Examiner in the current office action, relies entirely on teachings found nowhere else but in the present specification.

Brasseur et al. disclose a television/internet game show, which involves real people, wherein the method includes a step of allowing users (i.e., viewers) to vote on a predetermined number of randomly selected user profiles, where the voting is done over the Internet. A winner is chosen based on the user profile receiving the most votes, and then a broadcast is presented of the winner receiving a prize. The method further includes a step of videotaping the winner making purchases over a time frame in which the winner must spend the entire prize amount, where the videotaping is shown in real time over the Internet and excerpts of the videotaping are shown as delayed video on a future television broadcast. (See, column 1, lines 30 to 48.)

Brasseur et al. disclose the system and technical architecture necessary for enabling a broadcast game show involving viewer participation and voting to select a contest winner. However, nothing in the cited reference suggests applying such architecture to a child adoption proceeding. On

the contrary, the awarded prize is a sum of money that must be spent within a fixed time period. The contestants are not prospective parents and the awarded prize has no connection whatsoever to child adoptions.

AdoptionSolutions.com is an Internet registry for parents hoping to adopt a child ("parent registry") and for children waiting for adoptions ("waiting children"), in which photographs and profiles of both prospective parents and of children seeking adoption are presented. The website additionally includes information on adoption attorneys and agencies, pregnancy centers, and other information relevant to the adoption process.

AdoptionSolutions.com does not enable or involve third party "viewer" interaction in selecting adoptive parents from among parents featured in the parent registry. There is no means by which visitors to the website can vote on prospective parents, or whereby votes are tallied to select a winning parent.

In fact, at the time the present invention was made, it was contrary to conventional practices in the adoption industry to use a game show format with audience interaction and voting for selecting adoptive parents. Any connection between child adoptions and a television game show is found *only* in the present specification; there is absolutely no suggestion for any such connection in the prior art cited in the current rejection.

Moreover, published comments from professionals in the adoption industry establish that at the time the invention was made, and even to the present date, professionals in the field

regard "reality television" game shows as an inappropriate venue for selecting adoptive parents.

> Several adoption professionals said Tuesday that characterizing the adoption process as a competition is inappropriate and insensitive.
>
> "Whatever the outcome for people who watch the show, people who have gone through the process as birth parents or adoptees or who are in the field--they are generally upset because their lives are being depicted as a game show rather than as [part of] an intimate, lifelong process that is much more profound than is being depicted," said Adam Pertman, executive director of Evan B. Donaldson Adoption Institute, an adoption research non-profit organization in New York City.
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> ("'20/20' Bills Adoption Show as 'Reality' TV," Chicago Tribune article published April 28, 2004 concerning airing on ABC's 20/20 of an open adoption.)

These statements make clear that professionals in the adoption industry vehemently reject any linkage between the adoption process and game show competitions. Therefore, clearly, there is no incentive within the conventional prior art, including conventional adoption practices, to combine the features presented on the AdoptionSolutions.com website with a viewer participation game show format, such as described in Brasseur et al. Quite the contrary, the prior art and conventional wisdom in the adoption industry strongly teaches away from making such a combination. "The totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness." In re Hedges, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986)

Finally, addressing the Examiner's purported motivation to combine the cited references, on page 3, lines 4 to 7, of the Office Action, the Examiner states, "Therefore, it would have

been obvious to one having ordinary skill in the art at the time the invention was made to modify Brasseur to include the claimed limitations for the benefit of promoting child adoption by providing a child to [the] most deserving parent contestant."

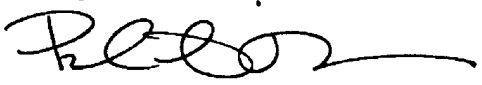
What is striking about the Examiner's statement is that it is not supported anywhere within the prior art cited in the Office Action. On the contrary, paraphrasing statements found nowhere else but in the present specification, the Examiner has merely restated an advantage of the invention highlighted by the present applicant. That is, as noted on page 4, lines 15 to 18, of the present specification, "The present invention overcomes the inequities of state-run and private adoption procedures by ... permitting a fairer selection process in which members of a viewing public can vote on the best capable parents." In essence, the Examiner has taken the applicant's own statements and used them as the suggestion for combining the prior art. This is a classic example of prohibited hindsight. When combining prior art teachings, a judgment of obviousness cannot include knowledge gleaned only from applicant's disclosure. In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

For the foregoing reasons, it is respectfully submitted that the claimed invention would not have been obvious to a person skilled in the art at the time the present invention was made. Reconsideration and withdrawal of the rejections, and allowance of pending claims 1 to 22, is respectfully requested.

As indicated above, the present response is accompanied by a request for a three-month extension of time for responding to the Office Action. The fees ($510.00) for this extension may be charged to the Attorney's Deposit Account No. 07-2519.

No additional fees are currently due. Notwithstanding, in the event that fees, or deficiencies in fees, are deemed necessary in connection with this or any accompanying communication, such fees may be charged to the Attorney's Deposit Account.

Respectfully submitted,



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